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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,979	03/26/2002	Reiner Fischer	Mo 7025/LcA 33,923	6710
34469	7590	03/08/2004	EXAMINER	
BAYER CROPSCIENCE LP			POWERS, FIONA	
Patent Department			ART UNIT	
100 BAYER ROAD			PAPER NUMBER	
PITTSBURGH, PA 15205-9741			1626	

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/088,979	Applicant(s) FISCHER ET AL.	
	Examiner Fiona T. Powers	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-12, 14, 15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-11 is/are allowed.
- 6) ☒ Claim(s) 1-4, 12, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 5 and 17-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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Receipt is acknowledged of the disclosure statement filed March 10, 2003 and the amendment filed December 3, 2003, which have been entered in the file.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 4, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art disclosed on page 5 of the specification and EP 528156, of record (which corresponds to US 5262383).

Determination of the scope and content of the prior art (MPEP §2141.01)

Page 5 of the specification excludes Compound I-a-79 from EP 528156 from the claimed compounds. EP 528156 is drawn to 3-aryl-4-hydroxy- Δ^3 -dihydrofuranones which are useful as insecticides, acaricides, herbicides and fungicides. Note the abstract. The compound is structurally similar to the claimed compounds where Het is the group (2) wherein G is hydrogen, one or more of X, Y and W is ethyl and the others are methyl, and V and Z are hydrogen.

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Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The compound of the prior art differs from that claimed in that it is a homolog of that claimed (i.e. one or more of X, Y and W is methyl instead of ethyl. However, homologs are considered obvious over one another.

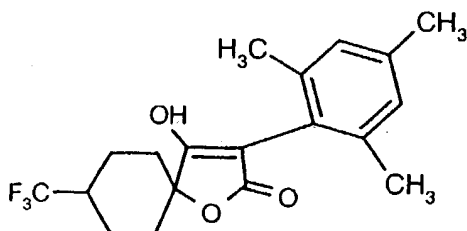
Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

Due to their close structural similarity one of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that compounds with similar properties would be obtained. The claimed compounds, pesticides and/or weed killers would have been rendered obvious by the admitted prior art disclosed on page 5 of the specification in the absence of any unobvious property. The claimed method for controlling at least one of a pest and a weed and the claimed method for preparing at least one of a pesticide and a weed killer would have also been rendered obvious in the absence of any unobvious result.

Applicant's arguments filed December 3, 2003 have been fully considered but they are not persuasive. Applicants arguments are directed to EP 528156. However, the claims are rejected over the combination of the admitted prior art on page

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5 of the specification and EP 528156. The comparative data in Tables A (pages 106-107), B (page 109), C (page 111), D (page 113), E (page 115) and F (page 117) has been considered and deemed not persuasive because the closest prior art compound has not been compared. The closest prior art compound is



which page 5 of the specification identifies as compound I-a-79 from EP 528156. In the telephone interview on September 30, 2003 applicants' attorney Richard Henderson stated that this compound is a part of the record (which is available to the public) for the EP application that corresponds to EP 528156 but it does not appear in the published application.

The examiner requests under 37 CFR 1.105 any document from the EP application which corresponds to EP 528156 that discloses compound I-a-79.

Claims 5 and 17 to 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 6 to 11 are allowed.

The references made of record and not relied upon show the state of the art. The references which are crossed out on form PTO-1449 are already of record on form PTO-892 which was included with the last Office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is (571)272-0702. The examiner can normally be reached on Monday - Friday 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fiona T. Powers

Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
March 2, 2004